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Application/Control Number: 09/945,258

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Applicant's election without traverse of Invention III, Claims 10 and 11 in Paper No. 8, filed May 22, 2003, is acknowledged. Claims 1-9 and 12-16 have been withdrawn from further consideration by the Examiner because these claims are drawn to non-elected inventions.

Priority is to September 1, 2000.

The IDS filed December 11, 2001 (Paper #5) has been reviewed and initialed and is attached hereto. The pending applications have been reviewed but are lined through because pending applications should not appear on the patent front. Because SN 09/227,725 has matured into USP 6,383,758, this patent is being cited on the attached PRO-892. A copy of the patent is not being provided.

The disclosure is objected to because of the following informalities: At page 8, line 2; page 9, line 2; and page 21, para. 2, sequence identifiers should be provided instead of database accession numbers.

Appropriate correction is required.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,020,143. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 10 and 11 are drawn to a method for identifying a compound that alters PAMP activity by combining PAMP, its substrate, and the compound and determining changes in PAMP activity. Patented Claim 1 is drawn to a method for identifying substances that affect the interaction of presenilin 1 interacting protein and presenilin. Presenilin interacting proteins include PAMP, as noted on page 21 of the instant specification. Presenilin is a substrate for PAMP, as noted on page 3 of the instant specification. Therefore, the instant claims are encompassed by the patented claims.

Claims 10 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,383,758. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 10 and 11 are drawn to a method for identifying a compound that alters PAMP activity by combining PAMP, its substrate, and the compound and determining changes in PAMP activity. Patented Claim 1 is drawn to a method for identifying substances that alter the interaction of presenilin binding protein and presenilin. As claimed, presenilin binding protein is not distinguished from PAMP. Presenilin is a substrate for PAMP, as noted on page 3 of the instant specification. Therefore, the instant claims are encompassed by the patented claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term presenilin associated membrane protein is indefinite because this term has no structural or functional limitations. Also, it is not clear how the method steps of claim 10 coincide with the preamble of claim 10, that is, it is not clear how a method of determining PAMP activity in the presence of a compound will result in a compound useful for treating neurological disorders.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351 (a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21 (2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 (c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 10 and 11 are rejected under 35 U.S.C. 102(a) as being anticipated by St. George-Hyslop et al. (USP 6,020,143; issued February 1, 2000).

Claims 10 and 11 are drawn to a method for identifying a compound that alters PAMP activity by combining PAMP, its substrate, and the compound and determining changes in PAMP activity. Patented Claim 1 is drawn to a method for identifying substances that affect the interaction of presenilin 1 interacting protein and presenilin. Presenilin interacting proteins include PAMP, as noted on page 21 of the instant specification. Further, there is no identifiable variables presented in the claim to distinguish PAMP from presenilin interacting protein of the patent. Presenilin is a substrate for PAMP, as noted on page 3 of the instant specification. Therefore, the instant claims are anticipated by the patent.

Claims 10 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by St. George-Hyslop et al. (USP 6,383,758; issued May 7, 2002; priority to January 9, 1998).

Claims 10 and 11 are drawn to a method for identifying a compound that alters PAMP activity by combining PAMP, its substrate, and the compound and determining changes in PAMP activity. Patented Claim 1 is drawn to a method for identifying substances that alter the interaction of presenilin binding protein and presenilin. As claimed, presenilin binding protein is not distinguished from PAMP. Presenilin is a substrate for PAMP, as noted on page 3 of the instant specification. Therefore, the instant claims are anticipated by the patent.

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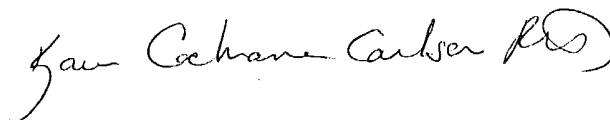
Claims 10 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Curtis et al. (WO 01/85912, claiming priority to US Patent Application 09/568,942, filed May 5, 2000). Curtis et al. teach presenilin enhancer proteins that bind to presenilin. At pages 15-16, Curtis et al. teach to screen compounds that modulate pen (presenilin enhancer proteins) by providing pen with a natural pen binding target, which is presenilin, in the presence of the compound and determine binding activity.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cochrane Carlson, Ph.D. whose telephone number is 703-308-0034. The examiner can normally be reached on 7:00 AM - 4:00 PM, off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Christopher Low can be reached on 703-308-2329. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER

March 16, 2004